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REMARKS

This Amendment is submitted in response to the Office Action dated January 8, 2006. In the Office Action, the Patent Office rejected Claims 1-11 and 29 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Patent Office rejected Claims 1 and 12 under 35 U.S.C. §102(b) as being anticipated by U.S. Application Publication No. 20020006887 to *Radwanski et al.* Further, the Patent Office rejected Claims 1, 4, 7, 11, 12, 14, 20 and 21 under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,723,428 to *Foss et al.* Still further, the Patent Office rejected Claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,610,173 to *Lindsay et al.* in view of U.S. Patent No. 5,789,326 to *Hansen et al.* and *Radwanski et al.*; and rejected Claims 13 and 23-28 under 35 U.S.C. §103(a) as being unpatentable over *Foss et al.* in view of U.S. Patent No. 5,921,062 to *Weder*.

By the present Amendment, Applicants amended Claims 1, 6-22, 24 and 26 and added new Claims 30-35. Applicants assert that the amendments to the claims and the remarks that follow overcome the objections and rejections made by the Patent Office and place the application in condition for allowance.

Applicants note with appreciation that the Patent Office indicated that Claims 15-19, 22 and 29 would be allowable if re-written in independent form including all of the limitations of the

base claim and any intervening claims. To this end, Applicants added new Claims 30-35 incorporating dependent Claims 15-19 and 22 into independent Claim 12 and added new Claim 35 incorporating dependent Claim 29 into independent Claim 26. Accordingly, Applicants submit that new Claims 30-35 are in allowable form.

With respect to the rejection of Claims 1-11 and 29 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, Applicants submit that the amendments to Claims 1 and 29 overcome the rejection by the Patent Office. In the Office Action, the Patent Office asserts that the original Specification only discloses that the antimicrobial layer may contain silver zeolite, not an antimicrobial surface made of silver zeolite. Independent Claim 1 has been amended to state that the antimicrobial surface "has silver zeolite". Therefore, Applicants submits that the objection to Claims 1-11 under 35 U.S.C. §112, first paragraph, has been overcome and should be withdrawn. Notice to that effect is requested.

Regarding Claim 29, the language of the Specification supports the language of Claim 29 that the separated liquid is located on the top surface of the sheet. The disclosure that the liquid is associated with the indented texture of the sheet (page 8, lines 23-26) and that the liquid is forced onto the surface (page 17, lines 28-31) indicate that the separated liquid is located on the top surface of the sheet. The "indented texture of the sheet" and

"the surface" both refer to the top surface of the sheet. Therefore, Applicants submits that the objection to Claim 29 under 35 U.S.C. §112, first paragraph, has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1-29 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention, Applicants submits that the amendments to Claims 13 and 24 replacing "indentation" with "indentations" overcome the rejection by the Patent Office.

In the Office Action, the Patent Office rejected Claims 1 and 12 under 35 U.S.C. §102(b) as being anticipated by *Radwanski et al.* More specifically, the Patent Office alleges that *Radwanski et al.* disclose an antimicrobial-containing wipe comprising a substrate layer to which silver zeolite is adhered.

Independent Claim 1, as amended, requires a paper having a base defined by a length and a width wherein the base has a top side and a bottom side wherein the bottom side is opposite the top side and further wherein the base forms a plane; an antimicrobial surface connected to the top side of the base wherein the antimicrobial surface covers the top side wherein the antimicrobial surface has silver zeolite; and a first water resistant layer located between the base and the antimicrobial surface.

Independent Claim 12, as amended, requires a process for making a paper having the steps of providing a sheet having a first side and a second side wherein the second side is opposite the first side wherein the sheet is substantially flat and forms a plane; connecting a first water resistant layer to the first side of the sheet; and connecting an antimicrobial layer to the first side of the sheet wherein the antimicrobial layer is made of polyethylene having silver zeolite wherein the first water resistant layer is located between the sheet and the antimicrobial layer.

Radwanski et al. merely disclose an antimicrobial wipe comprising a substrate layer to which an antimicrobial agent is adhered and one or more laminate layers. The method disclosed comprises provided a sheet of laminate material and laminating it to the substrate layer containing the antimicrobial agent.

Nowhere do Radwanski et al. disclose a paper having a base defined by a length and a width wherein the base has a top side and a bottom side wherein the bottom side is opposite the top side and further wherein the base forms a plane; an antimicrobial surface connected to the top side of the base wherein the antimicrobial surface covers the top side wherein the antimicrobial surface has silver zeolite; and a first water resistant layer located between the base and the antimicrobial surface as required by amended Claim 1.

Nowhere do *Radwanski et al.* disclose a process for making a paper having the steps of providing a sheet having a first side and a second side wherein the second side is opposite the first side wherein the sheet is substantially flat and forms a plane; connecting a first water resistant layer to the first side of the sheet; and connecting an antimicrobial layer to the first side of the sheet wherein the antimicrobial layer is made of polyethylene having silver zeolite wherein the first water resistant layer is located between the sheet and the antimicrobial layer as required by amended Claim 12.

Under 35 U.S.C. §102, anticipation requires that a single reference discloses each and every element of Applicants' claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d. 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial", and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Since *Radwanski et al.* fail to disclose the elements specifically defined in amended independent Claims 1 and 12, Applicants assert that the rejection of Claims 1 and 12 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected 1, 4, 7, 11, 12, 14, 20 and 21 under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,723,428 to *Foss et al.* More specifically, the Patent Office alleges that *Foss et al.* disclose an antimicrobial fiber and multilayered fibrous products made therefrom.

Foss et al. merely disclose a multilayered sheet with an antimicrobial layer on one or both sides. The sheet of *Foss et al.* has an antimicrobial layer on one surface and a water resistant layer on the opposite side with thicker support layers between them, in contrast to the claimed invention that requires a water resistant layer between the antimicrobial layer and the support sheet.

Nowhere do *Foss et al.* disclose a paper having a base which forms a plane; an antimicrobial surface connected to the top side of the base wherein the antimicrobial surface covers the top side wherein the antimicrobial surface contains silver zeolite; and a first water resistant layer located between the base and the antimicrobial surface as required by amended Claim 1.

Nowhere do *Foss et al.* disclose a process for making a paper having the steps of providing a sheet having a first side and a second side wherein the second side is opposite the first side wherein the sheet is substantially flat and forms a plane; connecting a first water resistant layer to the first side of the

sheet; and connecting an antimicrobial layer to the first side of the sheet wherein the antimicrobial layer is made of polyethylene having silver zeolite wherein the first water resistant layer is located between the sheet and the antimicrobial layer as required by amended Claim 12.

Since *Foss et al.* fail to disclose the elements specifically defined in amended independent Claims 1 and 12, Applicants assert that the rejection of Claims 1, 4, 7, 11, 12, 14, 20 and 21 under 35 U.S.C. §102(e) has been overcome and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over *Lindsay et al.* in view of *Hansen et al.* and *Radwanski et al.* More specifically, the Patent Office alleges that *Lindsay et al.* disclose a paper web usable in absorbent tissue products having a pattern of protrusions; *Hansen et al.* disclose zeolites with silver salts used in absorbent tissue products; and *Radwanski et al.* disclose silver zeolites used in wipes.

Lindsay et al. merely disclose a three-dimensional tissue and a method for imprinting a paper web during a wet pressing event which results in asymmetrical protrusions corresponding to the deflection conduits of a deflection member. Tissue webs produced via the method have sets of physical and geometrical properties, such as, for example, a pattern of or a repeating pattern of

protrusions having asymmetrical structures. *Lindsay et al.* disclose possible "opposing outer surfaces of the tissue". The possible opposing outer surfaces are disclosed in a "laundry list" of many possible surfaces that include a hydrophobic web opposite a more hydrophobic web and a web having antimicrobial agents opposite a web free of antimicrobial agents. (Column 31, lines 16-34) In contrast, the claimed invention requires a first water resistant layer located between the base and the antimicrobial surface.

Hansen et al. merely disclose the use of silver zeolite in fibrous tissue products and do not remedy the deficiencies of *Lindsay et al.* in regard to the structure of the present invention. As discussed above, *Radwanski et al.* merely disclose an antimicrobial wipe comprising a substrate layer to which an antimicrobial agent is adhered and one or more laminate layers. Thus, *Radwanski et al.* also does not remedy the deficiencies of *Lindsay et al.* with respect to the structure of the claimed invention.

Nowhere do *Lindsay et al.*, *Hansen et al.* or *Radwanski et al.*, taken singly or in combination, teach or suggest a paper having a base which forms a plane; an antimicrobial surface connected to the top side of the base wherein the antimicrobial surface covers the top side wherein the antimicrobial surface contains silver zeolite;

and a first water resistant layer located between the base and the antimicrobial surface as required by amended Claim 1.

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Lindsay et al.* with *Hansen et al.* or *Radwanski et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Specifically, there is no suggestion to select the hydrophobic web and the antimicrobial web from the "laundry list" of possible tissue components disclosed in *Lindsay et al.* and use those webs in combination. Further, there is no suggestion to use a combination of those webs with the teachings of *Hansen et al.* and *Radwanski et al.* It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicants' invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Lindsay et al.*, *Hansen et al.* and *Radwanski et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Lindsay et al.*, *Hansen et al.* and *Radwanski et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features positively recited in independent Claim 1. Accordingly, Applicants assert that the rejection of Claims 1-11 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 13 and 23-28 under 35 U.S.C. §103(a) as being unpatentable over *Foss et al.* in view of *Weder*, Applicants respectfully submit that the rejection has been overcome by the amendments and for the reasons that follow.

Independent Claim 26, as amended, requires a method for using a paper to protect against contamination. The method comprises the steps of: providing a sheet having a perimeter wherein the sheet has a bottom surface and a top surface wherein the top surface is opposite the bottom surface wherein an antimicrobial surface substantially covers the top surface wherein a water resistant layer resides between the top surface and the bottom surface and further wherein the sheet is made of a paper having a weight range between sixteen and a half pounds and ninety pounds wherein the sheet forms a plane and further wherein the antimicrobial surface is made of polyethylene having silver zeolite; positioning the sheet on a surface wherein the bottom surface of the sheet is adjacent to the surface wherein the surface is a substantially flat surface wherein the sheet covers the surface; and positioning an object on the antimicrobial surface wherein the object is within the perimeter of the sheet wherein the object is separated from the surface by the sheet.

As discussed above, Foss et al. disclose a multilayered sheet with an antimicrobial layer on one or both sides and an embodiment having an antimicrobial layer on one surface and a water resistant layer on the opposite side with thicker support layers between them, in contrast to the embodiment of the rejected claims that has the water resistant layer between the antimicrobial layer and the support sheet. Weder discloses a sheet of multiple layers and an

antimicrobial agent. *Weder* does not teach or suggest use of a hydrophobic layer between the top surface and the bottom surface of the sheet. Thus, *Weder* does not remedy the deficiencies of *Foss et al.* with respect to the claimed invention.

Neither *Foss et al.* nor *Weder*, taken singly or in combination, teaches or suggests a process for making a paper having the steps of providing a sheet having a first side and a second side wherein the second side is opposite the first side wherein the sheet is substantially flat and forms a plane; connecting a first water resistant layer to the first side of the sheet; and connecting an antimicrobial layer to the first side of the sheet wherein the antimicrobial layer is made of polyethylene having silver zeolite wherein the first water resistant layer is located between the sheet and the antimicrobial layer as required by amended Claim 12 from which Claims 13 and 23-25 depend.

Neither *Foss et al.* nor *Weder*, taken singly or in combination, teaches or suggests a method for using a paper to protect against contamination wherein the method requires providing a sheet having a perimeter wherein the sheet has a bottom surface and a top surface wherein the top surface is opposite the bottom surface wherein an antimicrobial surface substantially covers the top surface wherein a water resistant layer resides between the top surface and the bottom surface and further wherein the sheet is made of a paper having a weight range between sixteen and a half

pounds and ninety pounds wherein the sheet forms a plane and further wherein the antimicrobial surface is made of polyethylene having silver zeolite; positioning the sheet on a surface wherein the bottom surface of the sheet is adjacent to the surface wherein the surface is a substantially flat surface wherein the sheet covers the surface; and positioning an object on the antimicrobial surface wherein the object is within the perimeter of the sheet wherein the object is separated from the surface by the sheet as required by amended Claim 26.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features positively recited in independent Claims 12 and 26. Accordingly, Applicants assert that the rejection of Claims 13 and 23-28 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

In view of the foregoing remarks and arguments, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment. Therefore, entry of this Amendment is proper and should be effected. If, however, any outstanding issues remain, Applicants urge the Patent Office to telephone Applicants' attorney so that

the same may be resolved and the application expedited to issue. Applicants' request the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

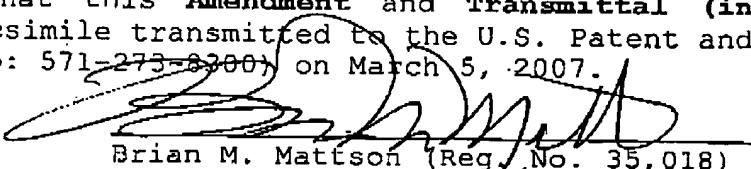


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CERTIFICATE OF TRANSMISSION

I hereby certify that this Amendment and Transmittal (in duplicate) are being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No: 571-273-8300) on March 5, 2007.



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